

REMARKS

Claims 33-50 and 52-54 are presently pending. Claims 33, 34, and 52 have been amended, and claim 51 has been canceled.

Rejections under 35 U.S.C. § 103

Independent claims 33 and 34 stand rejected under §103(a) as being unpatentable over the combination of U.S. Patent No. 6,449,344 to Goldfinger et al. ("Goldfinger") and U.S. Patent No. 6,389,127 to Vardi et al. ("Vardi"). Dependent claims 35-54 stand rejected under §103(a) as being unpatentable over various combinations of Goldfinger, Vardi, and U.S. Patent No. 5,848,134 to Sekiguchi et al. ("Sekiguchi"). Applicant respectfully traverses these rejections, and reconsideration of Applicant's pending claims is respectfully requested.

Hypothetical Combination does not Achieve Claimed Subject Matter.

As the PTO provides in MPEP § 2143, "[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 33

Claim 33, as amended, recites in part, "identifying a subscriber, a telephone number at which they can receive messages, and a predefined period of time for which they can receive messages at this number ..." Neither Goldfinger nor Vardi, alone or in combination, teach or suggest identifying a predefined period of time for which they can receive messages at a number or establishing the user's presence and ability to receive instant messages on the data network during the predefined time period, as is recited in

claim 33. The Examiner relies on Goldfinger at col. 6, lines 35-51 when addressing this element. However, the cited text of Goldfinger recites:

a user 34 establishing a connection to communications network 14 preferably in the same manner as described for user 18 in FIG. 1. Once user 34 is connected, information management apparatus 28 checks the list of sought users to determine if user 34 is sought by user 18. If so, information management apparatus 28 then checks the list of connected users to determine if user 18 is still connected. If user 18 is still connected, information management apparatus 28 causes annunciator 24 to transmit an annunciation to user 18, wherein the annunciation typically includes the unique identification code for sought user 34, the current network address for sought user 34, and preferably other information provided by user 18. Information management apparatus 28 preferably also checks the list of sought users to determine if user 18 is sought by user 34 and, if so, causes annunciator 24 to transmit an annunciation to user 34 as described above.
(Emphasis added.)

Accordingly, the cited text fails to teach or suggest a predefined period of time during which a message may be sent, but rather discloses that once a user is connected, the information management apparatus (after verifying that user 18 is still connected) "causes annunciator 24 to transmit an annunciation to user 18, wherein the annunciation typically includes the unique identification code for sought user 34, the current network address for sought user 34, and preferably other information provided by user 18" (emphasis added).

Furthermore, in the Advisory Action mailed on January 16, 2004, the Examiner states "claim 33 recites 'identifying ... a period of time for which they can receive messages' ..., the Examiner interprets this limitation 'identifying whether it is the right time for sending the message to the subscriber.' "

Applicant respectfully submits that the Examiner has misinterpreted the recited

element of claim 33, and has amended this element to more clearly distinguish the claimed invention over the cited references. More specifically, Applicant has amended claim 33 to recite a "predefined period of time" (which necessitates an earlier defining action), which Applicant believes is clearly different from identifying whether it is the "right time" (which is an instantaneous action, as described above in the cited text of Goldfinger).

Accordingly, the combined art fails to meet the standard presented by MPEP § 2143, which requires that the cited references must teach or suggest all the claim limitations to establish a prima facie case of obviousness. Therefore, claim 33 is allowable for at least this reason.

Claim 34

Claim 34, as amended, recites in part "identifying a telephone user as a subscriber, a telephone number at which they can receive messages, and a time range during which they can receive messages at this number. Claim 34 has also been amended to incorporate claim 51, reciting "sending a message from the subscriber to the selected data network user using an instant messaging protocol, wherein the message includes the telephone user's telephone number and a duration of time the telephone user will be available at that number."

As detailed previously with respect to claim 33, the combination of Goldfinger and Vardi fails to teach or suggest "identifying ... a time range during which they can receive messages at this number." Accordingly, claim 34 is allowable for at least this reason.

In addition, Applicant submits that claim 51 (now incorporated into claim 34) was improperly rejected. More specifically, in the Final Office Action mailed October 24, 2003, claim 51 was rejected over column 6, lines 52-65, of Goldfinger, which disclose

According to another embodiment of the present invention information management apparatus 28 checks the list of users who wish to be asked for authorization to determine if user 34 wishes to explicitly authorize requests

from seeking users for information regarding user 34. If explicit authorization is required from user 34, annunciator 24 transmits a request for authorization to authorization apparatus 36, typically resident in communications terminal 12. User 34 authorizes or declines the request from user 18 for location or other information relating to user 34. Authorization apparatus 36 then provides the authorization information to information management apparatus 28 which determines whether to cause annunciator 24 to transmit an annunciation to user 18.

Clearly Goldfinger is disclosing an authorization request from one user to another. While Goldfinger does disclose a "request from user 18 for location or other information relating to user 34," MPEP § 2143 requires that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added.) Goldfinger fails to teach or suggest a message that includes the telephone user's telephone number and a duration of time the telephone user will be available at that number. Furthermore, as described previously, nowhere does Goldfinger (or Vardi) teach or suggest a duration of time that a telephone user will be available at that number. Accordingly, claim 34 is allowable over the cited references.

Claims 35-50 and 52-54, which depend from and further limit claim 34, are allowable for at least the same reasons as claim 34.

Conclusion

It is respectfully submitted that independent claims 33 and 34 are in condition for allowance. Dependent claims 35-50 and 52-54 depend from and further limit claim 34 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

T.F. Z. Bliss

Timothy F. Bliss
Registration No. 50,925

Dated: February 24, 2003
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972/739-8638
Facsimile: 972/692-9101
File: 27238.13
R-67621_1.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 24, 2004.

Gayle Conner

Gayle Conner